

## Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

in re application of

Byron V. Bell, et al.

Serial No.: 10/619,975

Filed: July 15, 2003

For: HEATER CHIP CONFIGURATION  
FOR AN INKJET PRINthead  
AND PRINTER

Group Art Unit: 2853

Examiner: Stephens, Juanita D.

**PETITION UNDER 37 C.F.R. 1.181(a) TO WITHDRAW HOLDING OF**  
**ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION**

Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Notice of Abandonment mailed July 12, 2005, and in view of the following, Applicant respectfully petitions for withdrawal of the holding of abandonment of the above-identified application in accordance with 37 C.F.R. 1.181(a) and MPEP §711.03(c). Since Applicant is filing this petition within two months of the mailing date of the Notice of Abandonment, this petition is timely under 37 C.F.R. 1.181(f).

As background, on July 7, 2004, Applicant responded to the first, non-final Office Action mailed April 16, 2004. As this response addressed all outstanding issues, Applicant anticipated the issuance of a Notice of Allowance of pending claims 1-25. However, the next correspondence that Applicant received was not the Allowance but the Notice of Abandonment mailed July 12, 2005. As grounds for the abandonment, the Examiner references a failure to timely reply to an Office letter mailed September 15, 2004. To this end, Applicant submits that it never received the Office letter mailed September 15, 2004, and a search of Applicant's file jacket and docket records reveals the same.

For example, and in accordance with MPEP §711.03(c), Applicant submits attached *Exhibit A* showing a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed. As evidenced, *Exhibit A* shows recordation and docketing of all USPTO correspondence in this application *except* the September 15, 2004 letter. Additionally, Applicant submits attached *Exhibit B*, a print-out from the USPTO's Patent Application Information Retrieval (PAIR) system showing the index for the image file wrapper of the present application. Yet, this index fails to cite any correspondence for September 15, 2004. Accordingly, Applicant respectfully submits that the alleged correspondence was never made part of the file wrapper and possibly never mailed.

In view of the foregoing, Applicant respectfully requests revival of the above-identified application and the reissuance of the September 15, 2004 correspondence. *See Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971) (finding allegation with evidence that Office correspondence was not received sufficient grounds for granting petition to withdraw holding of abandonment).

As this is a petition under 37 C.F.R. 1.181(a), Applicant believes no fees are due, however, it authorizes the deduction of any necessary fees from Deposit Account 12-1213.

Respectfully submitted,  
**LEXMARK INTERNATIONAL, INC.**

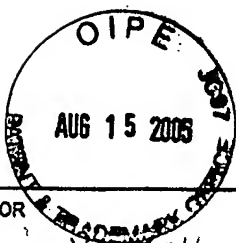


Scott N. Barker  
Registration No. 42,292

IP Law Department 865A  
740 W. New Circle Rd.  
Lexington, Kentucky 40550  
USA  
(859) 232-3668

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, on 8-11-05 by Paula D. Kiser.



## Exhibit A

**UNITED STATES PATENT APPLICATION**[illegible]

**Exhibit B**

Printer Friendly

10/619,975 Heater chip configuration for an inkjet printhead and printer

Image File Wrapper

This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click StartDownload.

Mail Room Date	Document Description	Page Count
07-12-2005	Abandonment	2
07-12-2005	Bibliographic Data Sheet	1
08-05-2004	Terminal Disclaimer Approval form used within the USPTO	1
08-02-2004	Fee Worksheet (PTO-875)	1
07-30-2004	Communication - Re: Power of Attorney (PTOL-308)	1
07-09-2004	Amendment - After Non-Final Rejection	1
07-09-2004	Claims	7
07-09-2004	Applicant Arguments or Remarks Made in an Amendment	6
07-09-2004	Power of Attorney (may include Associate POA)	7
07-09-2004	Terminal Disclaimer Filed	2
07-09-2004	Miscellaneous Incoming Letter	1
04-16-2004	Non-Final Rejection	10
04-16-2004	List of References cited by applicant and considered by examiner	1
04-16-2004	List of references cited by examiner	1
04-16-2004	Index of Claims	1
04-16-2004	Search information including classification, databases and other search related notes	1
04-08-2004	Examiner's search strategy and results	6
12-15-2003	Information Disclosure Statement (IDS) Filed	2
12-15-2003	Foreign Reference	10
07-15-2003	Transmittal letter	2
07-15-2003	Specification	17
07-15-2003	Claims	7
07-15-2003	Abstract	1

07-15-2003	Drawings	12
07-15-2003	Oath or Declaration filed	4
07-15-2003	Information Disclosure Statement (IDS) Filed	1
07-15-2003	Miscellaneous Incoming Letter	2
07-15-2003	Fee Worksheet (PTO-875)	1
07-15-2003	Fee Worksheet (PTO-875)	1

[Close Window](#)

not be regarded as pending after twelve months from its filing date under any circumstances.

\*\*>

### 37 CFR 1.181. *Petition to the Director.*

(a) Petition may be taken to the Director:<

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court:

\*\*>

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director: and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions in interferences, see § 1.644.<

\*\*\*\*\*

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

\*\*\*\*\*

## I. PETITION TO WITHDRAW HOLDING OF ABANDONMENT

A petition to revive an abandoned application (discussed below) should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, ~~and such petition does not require a fee.~~ Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

\*\*>Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based on unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

### A. *Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action*<

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. \*\*

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment.

Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d. 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

\*\*>

**B. *Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed***

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 CFR 1.10(c), (d), or (e) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by

the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

**C. *Treatment of Untimely Petition To Withdraw Holding of Abandonment***

37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may require a terminal disclaimer as a condition of granting an untimely petition to withdraw the holding of abandonment.

**1. *Design Applications, Utility Applications Filed Before June 8, 1995, and Plant Applications Filed Before June 8, 1995***

**(a) *Applicant Receives Notice of Abandonment***

In any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, if applicant receives a notice of abandonment, any petition to withdraw the holding of abandonment that is not filed within two months of the mail date of the notice of abandonment will **not** (absent extraordinary circumstances) be treated on its merits **unless** accompanied by a terminal disclaimer under 37 CFR 1.321(a), and the required fee set forth in 37 CFR 1.20(d). The period to be disclaimed is the terminal part of the term of any patent granted on the application, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under